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PAUL S MADAN
MADAN, MOSSMAN & SRIRAM, PC.
2603 AUGUSTA, SUITE 700
HOUSTON, TX 77057-1130

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JUL 15 2004

OFFICE OF PETITIONS

In re Application of
Christopher Shaw, Cindy Crow,
Bill Aeschbacher,
Sunder Ramachandran, Mitch Means
and Paulo Tubel
Application No. 10/641,350
Filed: August 14, 2003
Title: SUBSEA CHÉMICAL INJECTION
UNIT FOR ADDITIVE INJECTION AND
MONITORING SYSTEM FOR OILFIELD
OPERATIONS
Attorney Docket No. 194-26936-US

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(a)

This is in response to the "PETITION IN SUPPORT OF APPLICATION FILED UNDER 37 C.F.R. § 1.47(a) AND FEES UNDER 37 C.F.R. § 1.17(h)," filed May 12, 2004.

The petition is **DISMISSED**.

Rule 47 applicants are given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on August 14, 2003, without an executed oath or declaration. Accordingly, on November 12, 2003, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed the instant petition; the late surcharge under § 1.16(e); along with a declaration executed by inventors Shaw, Crow, Aeschbacher, Ramachandran and Means on behalf of themselves and on behalf of non-signing inventor Tubel. This response was made timely by an accompanying petition (and fee) for extension of time for response within the fourth month. Applicants assert that status under § 1.47(a) is proper because

joint inventor Tubel refuses to join in an application for patent or cannot be found after diligent effort.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Petitioner has not shown that inventor Tubel has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that attempts to present the declaration and assignment papers to inventor Tubel were made. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPO 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Tubel and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney.

Further correspondence with respect to this matter should be addressed as follows:

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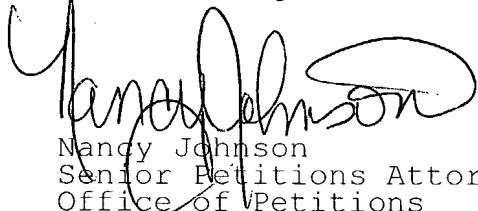
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ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

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Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions